



PATENT
Customer No. 22,852
Attorney Docket No. 05725.0637-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
David W. CANNELL et al.) Group Art Unit: 1617
Application No.: 09/820,954) Examiner: S.J. Sharareh
Filed: March 30, 2001) Confirmation No. 7371
For: COMPOSITIONS COMPRISING AT LEAST)
ONE AMINATED C₅-C₇ SACCHARIDE)
UNIT, AND THEIR USE FOR THE) **MAIL STOP AF**
PROTECTION AND/OR REPAIR OF)
KERATINOUS FIBERS)

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action dated March 23, 2005, the period for response having been extended two months by the accompanying petition and fee to August 23, 2005, Applicants respectfully request reconsideration of this application in view of the following remarks. A Notice of Appeal is filed concurrently herewith.

Claims 1-37, 39-57, and 59-79 are pending in this application. Claims 1-36, 40, 42, 44-46, 50-57, 59, 64, and 65 were withdrawn pursuant to a Restriction Requirement issued on February 22, 2002, as being directed to the non-elected subject matter. Claims 37, 39, 41, 43, 47-49, 60-63, and 66-77 were withdrawn pursuant to an Election Requirement issued on March 23, 2004, as being directed to non-elected species.

Therefore, claims 78 and 79 are currently subject to examination. No amendments were made after the Final Office Action.

Rejection under § 102(b) Is Improper Because *Riordan* Does Not Expressly Or Inherently Teach Each And Every Element Of Present Claims 78 and 79

The Examiner maintained the rejection of claims 78 and 79 under 35 U.S.C. § 102(b) as being anticipated by *Riordan* (U.S. Patent No. 5,866,142) ("*Riordan*"). Final Office Action, p. 2. This is the sole rejection in the Final Office Action. Applicants respectfully traverse this rejection for at least the following reasons.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." M.P.E.P. § 2131 (quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)) (emphasis added). Further, a rejection under § 102 is proper only when the claimed subject matter is identically described or disclosed in the prior art. *In re Arkley*, 455 F.2d 586, 587 (CCPA 1972) (emphasis added). The identical invention must be described in as complete detail as is contained in, and must be arranged as required by, the claim. M.P.E.P. § 2131.

The Examiner has failed to establish that each and every element in claims 78 and 79 of the present invention is either expressly or inherently described in *Riordan*.

A. *Riordan* Does Not Expressly Or Inherently Teach "The At Least One Glucosamine" As Recited In Present Claim 78

Specifically, *Riordan* does not expressly or inherently teach "the at least one glucosamine" as recited in Claim 78 of the present invention. Instead, *Riordan* merely teaches that its composition comprises, among other ingredients, N-acetyl-D-

glucosamine. See *Riordan*, col. 7, lines 16-44. N-acetyl-D-glucosamine is different from the at least one glucosamine claimed in Claim 78.

One example of the at least one glucosamine as recited in Claim 78 can be glucosamine HCl used in Example 2 of the present invention. Specification, page 25, lines 4-5.¹ Therefore, in view of the present disclosure, the term “glucosamine” recited in claim 78 should be construed as including the compound glucosamine itself and the salts thereof, such as glucosamine HCl used in Example 2 of the present invention. Further, as one of ordinary skill in the art understands in view of the instant specification, the term “glucosamine” does not include glucosamine’s derivatives, such as N-acetyl-D-glucosamine disclosed in *Riordan*.

In maintaining this rejection, the Examiner apparently tries to make the term “glucosamine” recited therein equivalent to the term “glucosamine and the derivatives thereof” by giving “claims their broadest reasonable interpretation in light of the supporting disclosure.” Final Office Action, pp. 3-4. However, by using the term “glucosamine” instead of the term “glucosamine’s derivatives” in present Claim 78, and in view of the use of the term derivative in other claims and in the specification when derivatives were intended to be recited, Applicants clearly indicate the scope of the protection they seek.

Therefore, the section 102(b) rejection of Claim 78 is improper.

¹ Glucosamine HCl is merely one example of glucosamine salts. Contrary to the Examiner’s allegation, Applicants never suggested that the “at least one glucosamine” is only directed to glucosamine HCL as used in Example 2.” See Final Office Action, p. 3.

B. *Riordan* Does Not Expressly Or Inherently Teach “The At Least One Additional Sugar” As Recited In Present Claim 79

In addition, *Riordan* does not expressly or inherently teach that the “at least one additional sugar [is] different from said at least one compound comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group and derivatives thereof” as recited in Claim 79 of the present invention. (Emphasis added).

It appears that the Examiner has mistakenly read “the second element of claim 79” (i.e., the at least one additional sugar) and alleges that “the second element of claim 79 includes a C₅ to C₇ saccharide unit [substituted] with at least one amino group and derivatives thereof, wherein such sugar is unsubstituted.” Final Office Action, p. 4. However, claim 79 recites that the at least one additional sugar is different from a compound “comprising at least one C₅ to C₇ saccharide unit substituted with at least one amino group and derivatives thereof” as recited in present Claim 79. In other words, the “at least one additional sugar” as recited in present Claim 79 does not include a “C₅ to C₇ saccharide unit substituted with at least one amino group and derivatives thereof.”

Riordan teaches that its composition comprises, among other ingredients, the sodium salt of hyaluronic acid. *Riordan*, col. 7, lines 16-44. As shown in Merk Index 7th ed. pages 751-752, which was cited by the Examiner in the Final Office Action, page 4, (a copy of which was provided by the Examiner in the record), hyaluronic acid comprises “at least one C₅ to C₇ saccharide unit substituted with at least one amino group and derivatives thereof.” Therefore, hyaluronic acid disclosed in *Riordan* does

not fall into the scope of the "at least one additional sugar" as recited in present Claim 79. Accordingly, the section 102(b) rejection of Claim 79 is improper.

Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and timely allowance of the rejected claims.

If there is any additional fee due in connection with the filing of this paper, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Thalia V. Warner, Reg. No. 39,064

By: *Ningling Wang*
Ningling Wang
Reg. No. 52,412

Dated: August 23, 2005